

REMARKS

Claims 1-2, 4-12, and 14-23 are pending in this application after this Amendment. Claims 20-23 have been added.

**Examiner Interview**

Applicant wishes to thank the Examiner for the interview conducted on July 21, 2004. During the interview, the parties discussed the distinction between the claimed invention and the cited art. Applicant specifically argued that the You et al. reference does not teach or suggest an information controller for extracting first and second information. Additionally, Applicant presented arguments that there is no motivation to combine the teachings of You et al. with the teachings of Amo et al. The Examiner indicated that he will update his search and respond accordingly.

**Prior Art Rejections**

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when

Appl. No. 09/785,308

combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In support of the Examiner's rejection of claim 1, the Examiner asserts that *You et al.* discloses an information controller 58 extracting first and second information. Applicant respectfully disagrees with the Examiner's characterization of this reference.

*You et al.* discloses a caption processing device and method for a display unit with a separate display where the caption is displayed separately from a monitor which displays the video signal so that partial covering of the video signal by the caption is avoided. Microcomputer 58 outputs a select signal SE to the switching unit 52 for applying caption data from the caption data processor 51 to the mixer 53 or the LCD driving circuit 55 and outputs a control signal CTL2 for processing caption data to the LCD driving circuit 55 (col. 4, lines 18-22).

In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an information display device comprising an information controller extracting the first and second information from the information received. It is respectfully submitted that there is no teaching or suggestion in *You et al.* that is directed to an information controller extracting first and second information from the information received.

Appl. No. 09/785,308

Amo et al. fails to cure the deficiencies of the teachings of You et al. as Amo et al. fails to teach or suggest an information controller as recited in claim 1. As neither of the references, either alone or in combination, teach or suggest all of the claimed elements, it is respectfully submitted that claim 1 is not obvious over You et al. in view of Amo et al.

As noted above, in order to establish *prima facie* obviousness under 35 U.S.C. § 103, the Examiner must provide motivation to modify the reference to combine the reference teachings. In support of the Examiner's rejection of claim 1, the Examiner asserts that

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it would have been obvious to one of ordinary skill in the art at the time of the invention to combine You et al. with Amo et al.'s information display device. The Examiner notes that by doing so, customized advertising information, as disclosed by Amo et al., could be substituted for captions. It is respectfully submitted that neither of the cited references provide any disclosure that would support this assertion. It appears that the Examiner is relying upon Applicant's specification in providing this motivation. It is respectfully submitted that the Examiner's reliance on Applicant's specification for providing his motivation amounts to improper hindsight. As the Examiner has failed to provide valid motivation for combining the references, it is respectfully submitted that the Examiner has failed to establish

Appl. No. 09/785,308

*prima facie* obviousness under 35 U.S.C. § 103. As such, it is respectfully requested that the outstanding rejection be withdrawn.

Finally, the Applicant maintains that one of ordinary skill would not be motivated to combine the teachings of *Amo et al.* with the teachings of *You et al.* The Applicant respectfully requests the Examiner consider the argument included in the Reply After Final filed February 25, 2004, and respond accordingly.

Based on all of the reasons set forth above, it is respectfully submitted that claim 1, together with claims dependent thereon, are not obvious over the references as cited by the Examiner.

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With regard to the Examiner's rejection of claims 4, 9, and 14 under 35 U.S.C. § 103(a) as being unpatentable over *You et al.* in view of *Minolta Camera* (JP 2001-100702), the Applicant respectfully submits that as the *Minolta Camera* reference was published April 13, 2001, subsequent to the filing date of the present application, namely, February 20, 2001, it is respectfully submitted that the *Minolta Camera* reference is not proper prior art. As such, it is respectfully requested that the outstanding rejections be withdrawn.

It is respectfully submitted that claims 6 and 11 contain elements similar to those discussed above with regard to claim 1 and, thus, claims 6 and 11, together with claims dependent thereon,

Appl. No. 09/785,308

are allowable for the reasons set forth above with regard to claim 1.

Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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